

THEOR 203.1 US (10107432)REMARKS

Claims 1-20 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Anne Thomas, "Container-Managed Persistence," Patricia Seybold Group, December 1998 (Thomas), and further in view of U.S. Patent No. 6,601,233 (Underwood). Applicants respectfully traverse this rejection.

As discussed previously in the amendment filed on July 26, 2004, applicants respectfully submit that only the present invention teaches or suggest "embedding code markers in said EJB source code to enable subsequent updates to said EJB source code," as required in claim 1. However, contrary to the Examiner's assertion, Underwood merely describes that "modification to the text phrases associated with each of the codes of the [code table framework] is permitted." (col. 17, lines 31-33; Fig. 1B) Further, Underwood describes that "The role of [the code table] framework is to store frequently used code/decode sets on the web server and provide services that enable the application developer to retrieve the decode(s) associated with code(s)." (col. 17, lines 61-64). A "framework basically is a collection of cooperating classes that make up a reusable design solution for a given problem domain." (col. 15, lines 19-21) Accordingly, Underwood merely describes providing reusable design solution by storing frequently used codes in the code table framework.

Applicants respectfully submits that Underwood describes a tool that essentially provides access to reusable codes, whereas the present invention provides a method for generating code for EJB components from a business process and embedding code markers in the EJB source code to enable subsequent updates to the EJB source code.

In other words, Underwood merely describes modifying the code table framework and contrary to the Examiner's assertion, Underwood does not teach or suggest modifying the EJB source code by "embedding code markers," as called for in claim 1. Applicants respectfully request that the Examiner provide a reference that one of ordinary skill in the art would find that modifying the code table framework of Underwood containing frequently used codes is equivalent to embedding the code markers in the EJB source code.

In view of the foregoing difference, it is respectfully submitted that the present invention recited in independent claim 1 is patentably distinct over the combination of Thomas and

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Underwood, even assuming *arguendo* that such combination is proper. Therefore, it is respectfully requested that the rejection of claims 1-20 under 35 U.S.C. §103 be withdrawn.

Additionally, there is no motivation in Thomas or in Underwood that the teaching of these two references should be combined. In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Fritch, (Fed. Cir. 1992) 91-1318; In re Laskowski, 10 U.S.P.Q. 2d 1397, 1299 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (1987) is quite relevant. There, the Federal Circuit stated:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

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“At best in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these known [agents]. However, this is not the standard of 35 U.S.C. Section 103.”

Moreover, absent applicants' disclosure, there appears to be absolutely no reason to add Underwood to Thomas so as to provide a method for generating code for EJB components from a business process and embedding code markers in the EJB source code to enable subsequent updates to the EJB, especially since these two references are concerned with completely different problems. In fact, the only reason one might turn to Underwood, if at all, is because of the hindsight gleaned from applicant's own disclosure. The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Redkin-Wiley, 5 U.S.P.Q. 2d, 1434, 1438 (Fed. Cir. 1988):

“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.”

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"...it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In Uniroyal, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Company, 221 U.S.P.Q. at 489, to conclude that "the mere fact that a device or process utilizes a known scientific principal does not alone make that device or process obvious." 5 U.S.P.Q. 2d at 1440.

In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

"The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference "upside down," the CAFC ruled:

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Thomas, would not even turn to Underwood – and if she did, she would not understand how or why Underwood's code table framework should be combined with Thomas' description of the EJB persistence mechanisms.

Further, it undeniable that neither Thomas nor Underwood is even remotely concern with the problem of providing provisions for subsequent updates by embedding code markers into the EJB source code, synchronizing the model and code, and round trip engineering support. Since applicant has recognized a problem not addressed by the cited prior art and solved that problem in a manner not suggested by either Thomas or Underwood, the basis for patentability of the claims is established. See In re Wright, 6 U.S.P.Q. 2d, 1959, 1961-1962 (Fed. Cir. 1988).

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There, the CAFC relied upon previous decisions requiring a consideration of the problem facing the inventor in reversing the Examiner's rejection. "The problem solved by the invention is always relevant". *Id.* at 1962. See also, *In re Rinehart*, 189 U.S.P.Q. 143, 149 (CCPA 1967), which stated that the particular problem facing the inventor must be considered in determining obviousness.

Absent evidence that the specific problem of providing provisions for subsequent updates, synchronizing the model and code, and round trip engineering support was even recognized by the prior art, there can be no finding that the invention as a whole would have been obvious. As stated by the PTO Board of Appeals in *Ex parte Breidt and Lefevre*, 161 U.S.P.Q. 767, 768 (1968), "an inventive contribution can reside as well in the recognition of a problem as in a solution". It further appears that the conclusion reached by the Board of Appeals in *Ex parte Minks*, 169 U.S.P.Q. 120 (1969), is here in point. There, the Board concluded that "[a]ppellant having discovered the source of the problem and solved the same . . . he is . . . entitled to patent protection". *Id.* at 121.

In view of the foregoing difference and authorities, it is submitted that the present invention recited in independent claim 1 is patentably distinct over the combination of Thomas and Underwood. Additionally, since neither Thomas nor Underwood is even aware of the problem addressed by applicant, and since the cited prior art reference does not suggest the solution defined by claim 1, these claim are unobvious and patentably distinct over the combination of Thomas and Underwood. Accordingly, it is requested that the rejection of claim 1-20 under 35 U.S.C. §103 be withdrawn.

Furthermore, the combination of Thomas and Underwood does not teach or suggest "adding business logic code between said code markers" embedded in the EJB source code and "synchronizing said UML model with said business logic code, thereby providing round trip engineering support", as required in claims 19 and 20, respectively. In fact, col. 17, lines 34-43, cited in Underwood by the Examiner, merely describes retrieving, modifying, updating various text phrases in the code table framework containing frequently used codes. Hence, contrary to the Examiner assertion, modifying the contents of the code table framework is not equivalent to adding business logic code between the code markers embedded in the EJB source code to enable subsequent updates to the EJB source code. Applicants respectfully request that the Examiner provide a reference that one of ordinary skill in the art would find that adding new

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code and text phrase to the code table framework of Underwood containing frequently used codes is equivalent to adding business logic code between the code markers embedded in the EJB source code to enable subsequent updates to the EJB source code.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of applicant's undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

On the bases of the above remarks, reconsideration and allowance of claims 1-20 are respectfully requested.

Applicant believes no fee is due. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. **THEOR 203.1 (10107432)** from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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